



Attorney Docket No. CALW-004/01US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: David W. JOHNSON *et al.* Confirmation No.: 1511

Serial No.: 10/698,424 Group Art Unit: 1638

Filed: November 3, 2003 Examiner: Keith O Neal Robinson

For: **ALFALFA PLANTS HAVING IMPROVED STANDABILITY AND/OR FAST RECOVERY AFTER HARVEST AND METHODS FOR PRODUCING SAME**

U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action ("Final Action") of September 22, 2006, Applicants respectfully request a review of the above-identified matter prior to filing of an Appeal Brief. A Notice of Appeal is filed herewith under 37 C.F.R. 41.31.

As discussed more fully below, Applicants believe that the Examiner has made clear errors in rejecting pending claims 2-4 and 6-19 under 35 U.S.C. § 112, first paragraph.

Written Description Rejection.

Claims 2-4 and 6-19 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

There appear to be two major points to the Examiner's position. First, the Examiner states that "Applicant claims the broad genus of *Medicago sativa* alfalfa plants having faster recovery after spring green-up and a 15% or greater more erect stems at late bloom and the specification does not provide an adequate written description for the claimed invention" (Final

Office Action, page 4, second full paragraph). Second, the Examiner states that “the selection and identification steps do not provide a sufficient written description of the claimed invention because it does not prove that Applicant had possession of the broad genus of *Medicago sativa* alfalfa plants having faster recovery after spring green-up and a 15% or greater more erect stem [sic] at late bloom” (Final Office Action, page 5, second paragraph). The Examiner also states that “there is no written description in the specification for each and every plant of the broad genus of *Medicago sativa* alfalfa plants having faster recovery after spring green-up and more erect stems” (Final Office Action, page 3, last paragraph). As an initial matter, Applicants note that they are not claiming just any *Medicago sativa* alfalfa plant with faster recovery and more erect stems, but rather are claiming *Medicago sativa* alfalfa varieties with 8% or greater faster recovery after spring green-up or after harvest coupled with having 15% or greater more erect stems at late bloom when compared to the best commercial check varieties available.

Therefore, Applicants are not claiming just any *Medicago sativa* alfalfa plants as alleged by the Examiner, but rather are claiming *Medicago sativa* alfalfa varieties with specific and clearly defined traits hitherto unknown to those skilled in the art of alfalfa breeding as evidenced the lack of any pending prior art rejections.

Vas-Cath Inc. v. Mahurkar, which is relied upon by the Examiner to support this rejection, held that “to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed.” *Id*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). See, also, the US PTO’s position on the teachings of this case as provided at M.P.E.P. § 2163.02. As discussed *supra* and in great detail in the Response/Amendment filed in response to the First Office Action,

Applicants have clearly met the standard for the written description requirement set forth in *Vas-Cath Inc. v. Mahurkar*. The presently pending claims clearly set forth exactly how a potential infringer can determine whether a particular *Medicago sativa* alfalfa variety falls within the metes and bounds of the claimed invention, wherein the claimed elements of those metes and bounds are clearly and explicitly set forth in the as-filed specification as explained at page 9 in the Amendment and Response Under 37 C.F.R. § 1.111.

Furthermore, the as-filed specification provides detailed written descriptions of the development of four very different and distinct *Medicago sativa* alfalfa varieties derived from diverse genetic background, wherein each of these varieties clearly meet the limitations of the claims (see, for example, Example 3, pages 25-45). Anyone skilled in the art of alfalfa variety development can follow the procedures described in the as-filed specification to develop additional varieties which fall within the limitations of the claimed genus of alfalfa varieties with 8% or greater faster recovery after spring green-up or after harvest and 15% or greater more erect stems at late (i.e., 75% bloom) when compared to the specific adapted check alfalfa varieties as set forth in the claims. Alternatively, one skilled in the art can use any of Applicant's inventive, disclosed and deposited alfalfa varieties to develop additional alfalfa varieties which meet the claimed limitations. Applicants believe that it is a clear error for the Examiner to maintain this rejection because the as-filed specification conveys the invention to the public with reasonable clarity, Applicants' were clearly in possession of the invention at the time of filing, and that invention is now what is being claimed.

Enablement Description Rejection.

Claims 2-4 and 9-19 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. [Note: Claims 6-8 are not included in this rejection.]

The Examiner maintains that “it would require undue trial and error experimentation for one skilled in the art to determine which combinations . . . would produce the claimed invention” (Final Office Action, page 6, second full paragraph). The Examiner further alleges that “without knowing the genetic, morphological and/or physiological characteristics of the parental lines used to develop the claimed invention one skilled in the art would not know how to make and use the claimed invention” (*Id.*).

Applicants respectfully direct the panel’s attention to the very detailed and complete analysis of each of the eight considerations in *In re Wands*, 858F 2d 731, 9 USPQ2d 1400 (Fed. Cir. 1988), as set forth at pages 14-19 of the Amendment and Response Under 37 C.F.R. § 1.111. As far as Applicants can determine, the Examiner is now only concerned with the following *Wands* factors: (1) breadth of the claims; (2) the level of predictability in the art; and (3) the amount of direction provided by the inventors.

Breadth of the claims. The panel is respectfully requested to review the response to this factor provided in the Amendment and Response Under 37 C.F.R. § 1.111 at pages 14-16. If the Examiner’s extremely broad-stroked rejection is maintained, then there appears to be no way any inventor of a “genus” plant breeding invention can ever obtain claims to anything broader than a narrow “species” claim. Clearly, that is not the standard set by Congress, the courts or the U.S. Patent & Trademark Office and the Examiner is in clear error of this standard.

The level of predictability in the art. The panel is respectfully requested to review the response to this factor provided in the Amendment and Response Under 37 C.F.R. § 1.111 at pages 17-18. As explained therein, alfalfa breeding is a predictable art where, like here, Applicants have provided a clear and detailed plant breeding roadmap to accomplishing the

claimed invention. Surely, in view of Applicants' disclosure, the claimed invention is predictable and the Examiner's rejection is a clear error.

The amount of direction provided by the inventors. The panel is respectfully requested to review the response to this factor provided in the Amendment and Response Under 37 C.F.R. § 1.111 at page 18. As explained there and elsewhere in that document, the genetic, morphological and/or physiological characteristics of the parents are not directly relevant given that Applicants have demonstrated the methods to be used to develop four different, distinct *Medicago sativa* alfalfa varieties each derived from a diverse parental background and each possessing the claimed traits. What is important is that Applicants have provided the necessary direction for one skilled in the alfalfa breeding arts to develop further *Medicago sativa* alfalfa varieties with the claimed characteristics and the Examiner's rejection is a clear error.

SUMMARY

The panel is respectfully to reconsider the pending rejections and to find Applicants' claims allowable based on their originally filed specification, previously filed responses, and this pre-appeal brief request for review and to recognize that the pending claims are allowable.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1283.

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Respectfully submitted,
COOLEY GODWARD KRONISH LLP

Cooley Godward Kronish LLP
ATTN: Patent Group
1200 19th Street, NW, 5th Floor
Washington, DC 20036
Tel: (202) 842-7800
Fax: (202) 842-7899

By:

Erich E. Veitenheimer
Erich E. Veitenheimer
Reg. No. 40,420